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CUSTOMER NUMBER, 34,986
Docket No. 01064.0011-05000IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Richard LEVY) Group Art Unit: 1714
Serial No.: 09/359,809) Examiner: Cephia Toomer
Filed: July 21, 1999)
For: LUBRICANT COMPOSITIONS AND)
METHODS)

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

APPELLANT'S JANUARY 11, 2008 AMENDMENT OF THEIR DECEMBER 4, 2007
BRIEF ON APPEAL PURSUANT TO 37 C.F.R. § 41.37

The January 8, 2008 Office communication found that the appellant's brief filed on December 4, 2007 "does not map independent claim(s) (74 and 82) to the specification by page number and line number. . . .The support for the claims (page and line number or paragraph number must be shown within the paragraph discussing the independent claim. An entirely new Appeal Brief does not have to be submitted-just the defective section." (Closed parentheses missing from original.) (January 8, 2008 Office communication, page 2, par. 10.)

Appellant's attorney will set out the pertinent parts of the December 4, 2007 Brief relating to claims 74 and 82, and will supplement the December 4 description of the support for these claims in the written description with added material set out in **bold face type** to aid in comparing the old text with the new.

The December 4 Brief set out the support for independent claim 74 as follows:

Independent claim 74 relates to that aspect of the invention comprising a lubricant composition of matter comprising a product produced by the process of claim 73. This brief gives the claim 73 references to the page number and line or paragraph numbers of the written description. (December 4 Brief p. 5, par. 4)

Claim 73 in turn referred to:

an aspect of the invention comprising a process for manufacturing a lubricant composition comprising a polymer where the polymer comprises a superabsorbent polymer that absorbs more than about 100 times its weight in water described inter alia in the paragraph bridging pages 20-21 through page 25, line 2. The process involves combining the polymer with a material for lubricating a surface where the material for lubricating a surface comprises:

(1) a lubricating metal described inter alia on page 15, paragraph 2, 17, paragraph 3, and page 27, lines 11-13; alloys thereof described inter alia on page 27, line 11; a lubricating metal chalcogen compound described inter alia on page 17, lines 8-9 from the bottom, page 27, lines 3-6; halide described inter alia on page 27, lines 8, 9; carbonate described inter alia on page 27, lines 9-10; silicate described inter alia on page 10, line 11, page 13, first full paragraph; or phosphate described inter alia on page 27, lines 17-18; or a particulate lubricating metal nitride described inter alia on page 27, line 8; or a carbon lubricant described inter alia on page 4, line 10, page 13, line 5 from the bottom of the page, page 14, line 13, page 40 lines 9-10 from the bottom of the page; or

(2) a silicate ester described inter alia on page 13, first full paragraph; polyphenyl ether described inter alia on page 10, line 11; organic phosphate described inter alia on page 8, lines 5-6 from the bottom, page 10, line 10; chlorinated biphenyl page 12, line 11; phenanthrene described inter alia on page 17, line 7, page 27, line 2 from the bottom; or a phthalocyanine compound described inter alia on page 13, last line page 14, line 5 from the bottom, page 17, lines 7-10;

(3) where the material for lubricating a surface optionally contains a lubricant comprising an, organic lubricant described inter alia on page 17, paragraph 2. page

22, first full paragraph, the paragraph bridging pages 27-28, the paragraph bridging pages 28-29, inorganic lubricant described *inter alia* in the paragraph bridging pages 15-16 to paragraph 1 on page 17, or lubricant additive described inter alia on pages 7-10;

(4) or mixtures thereof described inter alia in the paragraph bridging pages 23-24 through line 2 of page 25, page 26, first full paragraph, page 26 second full paragraph, page 28, first full paragraph to page 29, first full paragraph. (December 4 Brief p. 3, last par. through p.4)

Appellant now sets out support for independent claim 74 "A lubricant composition of matter comprising a product produced by the process of claim 73" as follows:

Independent claim 73 (which claim 74 expressly refers to) relates to an aspect of the invention comprising a process for manufacturing a lubricant composition comprising a polymer where the polymer comprises a superabsorbent polymer that absorbs more than about 100 times its weight in water described inter alia in the paragraph bridging pages 20-21 through page 25, line 2. The process involves combining the polymer with a material for lubricating a surface where the material for lubricating a surface comprises:

(1) a lubricating metal described inter alia on page 15, paragraph 2, 17, paragraph 3, and page 27, lines 11-13; alloys thereof described inter alia on page 27, line 11; a lubricating metal chalcogen compound described inter alia on page 17, lines 8-9 from the bottom, page 27, lines 3-6; halide described inter alia on page 27, lines 8, 9; carbonate described inter alia on page 27, lines 9-10; silicate described inter alia on page 10, line 11, page 13, first full paragraph; or phosphate described inter alia on page 27, lines 17-18; or a particulate lubricating metal nitride described inter alia on page 27, line 8; or a carbon lubricant described

inter alia on page 4, line 10, page 13, line 5 from the bottom of the page, page 14, line 13, page 40 lines 9-10 from the bottom of the page; or

(2) a silicate ester described inter alia on page 13, first full paragraph; polyphenyl ether described inter alia on page 10, line 11; organic phosphate described inter alia on page 8, lines 5-6 from the bottom, page 10, line 10; chlorinated biphenyl page 12, line 11; phenanthrene described inter alia on page 17, line 7, page 27, line 2 from the bottom; or a phthalocyanine compound described inter alia on page 13, last line page 14, line 5 from the bottom, page 17, lines 7-10;

(3) where the material for lubricating a surface optionally contains a lubricant comprising an, organic lubricant described inter alia on page 17, paragraph 2, page 22, first full paragraph, the paragraph bridging pages 27-28, the paragraph bridging pages 28-29, inorganic lubricant described inter alia in the paragraph bridging pages 15-16 to paragraph 1 on page 17, or lubricant additive described inter alia on pages 7-10;

(4) or mixtures thereof described inter alia in the paragraph bridging pages 23-24 through line 2 of page 25, page 26, first full paragraph, page 26 second full paragraph, page 28, first full paragraph to page 29, first full paragraph.

Page 21, lines 1-8 describe the invention as relating to a product produced by the process of the invention.

The January 8, 2008 Office communication also found Claim 82 unsupported by the description in the December 4 Brief that stated:

Independent Claim 82 relates to that aspect of the invention which is a lubricant composition of matter comprising a lubricant composition of matter comprising a product produced by the process comprising forming a

mixture comprising a polymer where the polymer comprises a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, wherein the material for lubricating a surface comprises a solid lubricant and water, and wherein the composition optionally comprises a lubricant additive. The foregoing discussion of claim 81 in this brief indicates where the written description supports all of the claim 82 elements. (December 4 Brief, par. bridging pp. 6-7.)

In turn, the Claim 81 reference in the December 4 Brief notes:

Independent Claim 81 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein the material for lubricating a surface comprises an oil or greases thereof and water, and wherein the composition optionally comprises a lubricant additive. The foregoing discussion of claim 73 in this brief indicates where the written description supports all of the claim 81 elements but for the element comprising an oil or greases thereof and water. The written description supports this inter alia at page 26, paragraph 4, page 25, line 19, page 26, line 2, and page 28, first full paragraph, and page 29, lines 11-20. (December 4 Brief p. 6, first full par.)

This discussion of Claim 81 referring back to Claim 73 set out in the December 4 Brief notes Claim 73 comprises:

an aspect of the invention comprising a process for manufacturing a lubricant composition comprising a polymer where the polymer comprises a superabsorbent polymer that absorbs more than about 100 times its weight in water described inter alia in the paragraph bridging pages 20-21 through page 25, line 2. The process involves combining the

polymer with a material for lubricating a surface where the material for lubricating a surface comprises:

(1) a lubricating metal described inter alia on page 15, paragraph 2, 17, paragraph 3, and page 27, lines 11-13; alloys thereof described inter alia on page 27, line 11; a lubricating metal chalcogen compound described inter alia on page 17, lines 8-9 from the bottom, page 27, lines 3-6; halide described inter alia on page 27, lines 8, 9; carbonate described inter alia on page 27, lines 9-10; silicate described inter alia on page 10, line 11, page 13, first full paragraph; or phosphate described inter alia on page 27, lines 17-18; or a particulate lubricating metal nitride described inter alia on page 27, line 8; or a carbon lubricant described inter alia on page 4, line 10, page 13, line 5 from the bottom of the page, page 14, line 13, page 40 lines 9-10 from the bottom of the page; or

(2) a silicate ester described inter alia on page 13, first full paragraph; polyphenyl ether described inter alia on page 10, line 11; organic phosphate described inter alia on page 8, lines 5-6 from the bottom, page 10, line 10; chlorinated biphenyl page 12, line 11; phenanthrene described inter alia on page 17, line 7, page 27, line 2 from the bottom; or a phthalocyanine compound described inter alia on page 13, last line page 14, line 5 from the bottom, page 17, lines 7-10;

(3) where the material for lubricating a surface optionally contains a lubricant comprising an, organic lubricant described inter alia on page 17, paragraph 2, page 22, first full paragraph, the paragraph bridging pages 27-28, the paragraph bridging pages 28-29, inorganic lubricant described inter alia in the paragraph bridging pages 15-16 to paragraph 1 on page 17, or lubricant additive described inter alia on pages 7-10;

(4) or mixtures thereof described inter alia in the paragraph bridging pages 23-24 through line 2 of page 25, page 26, first full paragraph, page 26 second full paragraph, page 28, first full paragraph to page 29, first full paragraph. (December 4 Brief p. 3, last par. through p.4)

Thus in response to the January 8, 2008 Office communication finding alleged inadequate support in the December 4 Brief for claim 82, appellant responds that Independent Claim 82 relates to that aspect of the invention which is a lubricant composition of matter comprising a lubricant composition of matter

comprising a product produced by the process comprising forming a mixture comprising a polymer where the polymer comprises a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, wherein the material for lubricating a surface comprises a solid lubricant and water, and wherein the composition optionally comprises a lubricant additive. Claim 81 in this brief Indicates where the written description supports all of the foregoing claim 82 elements.

Further in this regard Claim 81 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein the material for lubricating a surface comprises an oil or greases thereof and water, and wherein the composition optionally comprises a lubricant additive. The foregoing discussion of claim 73 in this brief indicates where the written description supports all of the foregoing claim 81 elements but for the element comprising an oil or greases thereof and water. The written description supports this inter alia at page 26, paragraph 4, page 25, line 19, page 26, line 2, and page 28, first full paragraph, and page 29, lines 11-20.

The Claim 73 elements that support both the Claim 81 and Claim 82 elements comprises a superabsorbent polymer that absorbs more than about 100 times its weight in water described inter alia in the paragraph bridging pages 20-21 through page 25, line 2. The polymer is combined with a material for lubricating a surface where the material for lubricating a surface that comprises:

(1) a lubricating metal described inter alia on page 15, paragraph 2, 17, paragraph 3, and page 27, lines 11-13; alloys thereof described inter alia on page 27, line 11; a lubricating metal chalcogen compound described inter alia on page 17, lines 8-9 from the bottom, page 27, lines 3-6; halide described inter alia on page 27, lines 8, 9; carbonate described inter alia on page 27, lines 9-10; silicate described inter alia on page 10, line 11, page 13, first full paragraph; or phosphate described inter alia on page 27, lines 17-18; or a particulate lubricating metal nitride described inter alia on page 27, line 8; or a carbon lubricant described inter alia on page 4, line 10, page 13, line 5 from the bottom of the page, page 14, line 13, page 40 lines 9-10 from the bottom of the page; or

(2) a silicate ester described inter alia on page 13, first full paragraph; polyphenyl ether described inter alia on page 10, line 11; organic phosphate described inter alia on page 8, lines 5-6 from the bottom, page 10, line 10; chlorinated biphenyl page 12, line 11; phenanthrene described inter alia on page 17, line 7, page 27, line 2 from the bottom; or a phthalocyanine compound described inter alia on page 13, last line page 14, line 5 from the bottom, page 17, lines 7-10;

(3) where the material for lubricating a surface optionally contains a lubricant comprising an, organic lubricant described inter alia on page 17,

paragraph 2, page 22, first full paragraph, the paragraph bridging pages 27-28, the paragraph bridging pages 28-29, inorganic lubricant described *inter alia* in the paragraph bridging pages 15-16 to paragraph 1 on page 17, or lubricant additive described *inter alia* on pages 7-10;

(4) or mixtures thereof described *inter alia* in the paragraph bridging pages 23-24 through line 2 of page 25, page 26, first full paragraph, page 26 second full paragraph, page 28, first full paragraph to page 29, first full paragraph.

Page 21, lines 1-8 describe the invention as relating to a product produced by the process of the invention.

It should become apparent that appellant gave support for the Claim 74 and Claim 82 elements in the December 4 Brief by reference back to other claims in the Brief that specified by page, line and in some instance paragraph number where all of the elements found support in the written description. Apparently reference to these elements in other claims does not give the guidance needed to find written description support for Claim 74 and Claim 82, but rather the January 8, 2008 Office communication requires reiteration of the support in every instance and every claim, even though the December 4 Brief pointed out elements in Claim 74 and Claim 82 that also appeared in a previous description of claims 73, and 81 that specified where to find those elements in the written description.

Conclusions

Appellant requests the Board to reverse the examiner in all respects and remand the application to the examiner for the issuance of a Notice of Allowance. If the Board overrules the prior art and 35 U.S.C. § 112 rejections in this application and sustains the

provisional double patenting rejection, appellant similarly requests the Board to remand the application to the examiner for issuance of a Notice of Allowance pursuant to M.P.E.P. § 804(l) (B).

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

By: / Robert J. Eichelburg, Reg. No 23,057/

Dated: January 11, 2008

Robert J. Eichelburg

CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that the foregoing Amendment to the Brief on Appeal is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, facsimile telephone number (571) 273-8300 on the date indicated below.

By: /Robert J. Eichelburg, Reg. No. 23,057/
Robert J. Eichelburg

Dated: January 11, 2008